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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,020	02/17/2006	Kyoichi Shirota	0425-1197PUS1	8142

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EXAMINER

USELDING, JOHN E

ART UNIT	PAPER NUMBER
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4171

NOTIFICATION DATE	DELIVERY MODE
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04/11/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/542,020	Applicant(s) SHIROTA ET AL.	
	Examiner John Uselding	Art Unit 4171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4,5 and 7-9 is/are allowed.
- 6) ☒ Claim(s) 1-3,6,10 and 11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/11/2005, 10/11/2005</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claim 10 provides for the use of an additive, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 6, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirota et al. (4,479,893).

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4. Hirota et al. teach a composition containing phosphoric monoesters and diesters (column 5, lines 45-47), ionic surfactants (column 2, line 37), and nonionic surfactants (column 3, line 22).

5. Regarding claim 1: Applicant claims a monoester and a diester wherein the monoester weight content ranges from 0.4 to .95. Hirota et al. teach a limited Markush of what the phosphoric mono and diesters could be in their invention. There are species of their Markush that anticipate the Markush of the applicant in claim 1. An example of a phosphoric monoester that would fit the Markush of the applicant and Hirota et al. is 2-(dodecyloxy)ethyl dihydrogen phosphate. An example of a phosphoric diester that would fit the Markush of the applicant and Hirota et al. is bis(2-(dodecyloxy)ethyl) hydrogen phosphate. Hirota et al. also teach the weight ratio of their monoester to diester. Given that the weight ratio could be 50/50 (column 5, lines 45-47) the weight content according to applicants formula is 0.5.

6. Regarding claim 2: applicant adds to the composition (1) a nonionic compound having a C8 to C26 alkyl group and a polyoxyalkylene group comprising a C2 to C4 oxyalkylene group wherein the average added mole number is 3-400 and (2) an ionic compound having a C8 to C26 alkyl group and a polyoxyalkylene group comprising a C2 to C4 oxyalkylene group wherein the average added mole number is 5-400. Hirota et al. teach using an ionic surfactant and a nonionic surfactant. The nonionic surfactant (1) is disclosed as having an alkyl group of 8-20 carbons and a polyoxyethylene group wherein the average added mole number is 3-12 (column 3, lines 22-26). The ionic surfactant (2) is disclosed as having an alkyl group of 8-20 carbons and a

polyoxyethylene group wherein the average added mole number is 0.5-8 (column 2, lines 41-45).

7. Regarding claim 3: applicant claims that the nonionic compound is represented by one of the formulas given. Hirota et al. teach the use of a nonionic compound that meets the limitations of formula (2). The polyoxyethylene alkyl of 8-20 carbons (column 3, lines 22-26) fits the Markush of formula (2). The compound of Hirota et al. contains 3-12 mols of oxyethylene (column 3, lines 22-26).

8. Regarding claim 6: applicant claims a new formula for the mono and diester. Both of the examples given above of 2-(dodecyloxy)ethyl dihydrogen phosphate and bis(2-(dodecyloxy)ethyl) hydrogen phosphate also meet the limitations of formula (1-1).

9. Regarding claim 11: applicant claims adding the composition of claim 1 to a hydraulic composition. The most basic definition of hydraulic is something that is operated, moved or effected by means of water. Since Hirota et al. uses their composition in a shampoo, it is moved and effected by means of water (column 8, lines 30-39).

Allowable Subject Matter

10. Claims 4-5, and 7-9 are allowed. The composition of claims 1-3 and the copolymer of claim 4 are not novel. The composition is taught as a shampoo composition by Hirota et al. (4,479,893). The copolymer is taught by Yamato et al. (5,707,445 and 6,239,241) to be used in a concrete admixture to reduce the viscosity of hydraulic compositions. It is not obvious to combine the copolymer of Yamato et al. with

the shampoo composition of Hirota et al. The prior art also does not teach the composition of claim 1 combined with a hydraulic powder.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Uselding whose telephone number is (571)270-5463. The examiner can normally be reached on Monday-Thursday 6:00a.m. to 4:30p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. Lawrence Tarazano/
Supervisory Patent Examiner, Art Unit 4174

John Uselding
Examiner
Art Unit 4171

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